



AF/IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Daisuke KAMIYA

Group Art Unit: 1711

Application No.: 10/505,409

Examiner: Thao T. Tran

Filed: October 24, 2004

Attorney Docket No.: 7378/84103

Confirmation No. 7763

Customer No.: 42798

RESPONSE TO NOTICE DATED DECEMBER 29, 2006

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Miscellaneous Paper dated December 29, 2006, as entered in the above-captioned matter, the Appellants' Appeal Brief was identified as defective for the reason "[t]he independent claims 1 and 5 should be clearly provided and the claims should be explicitly mentioned or referred to in the Summary Section."

The Appellant has carefully reviewed the summary section and, with all due respect, finds the present text to be fully compliant with the requirements of 37 C.F.R. §41.37. Particular reference was made in the Miscellaneous Paper with respect to the requirements of 35 C.F.R. §41.37(c)(1)(v). That section first requires:

A concise explanation of *the subject matter* defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawings, if any, by reference characters.

(emphasis added). This is exactly what the present summary section in the Appeal Brief provides. The *subject matter* of the independent claims is presented, in prose format, including references to the specification by page and line number. The *subject matter* of independent claim 1 is summarized in the Summary Section as seen from the attached marked-up copy of the

Appeal Brief. The **subject matter** of independent claim 5 is summarized in the Summary Section as seen from the attached marked-up copy of the Appeal Brief. The citations to the specification in the Summary Section are exemplary and are intended to assist the reader in comprehending the **subject matter** of the claims involved in the Appeal, without being an estoppel against Appellant.

This portion of the Code of Federal Regulations then provides as follows:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. §112, 6th paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

There are no independent or dependent claims being presented for argument that include a means plus function or step plus function recitation. Therefore, this section of 35 C.F.R. §41.37(c)(1)(v) is not applicable.

There are no other specific requirements set forth in the Code of Federal Regulations.

It is understood that the PTO has issued a crib sheet that lists items to look for in order to assert any given appellants Appeal Brief is non-compliant. A copy of that crib sheet is hereby specifically requested.¹

Applicants' legal representative acknowledges the Examiner's courtesy in a telephone call on or about January 9, 2007. The Examiner was uncertain whether she had the authority to

¹ It is noted that other Group Art Units have acknowledged their staff are required to adhere to a PTO-issued crib sheet that itemizes non-substantive bases from which to select a reason to refuse an Appeal Brief. Through attorney organizations, and through its own experiences, the offices of the undersigned have seen Notices of Non-Compliant Appeal Briefs that allege a "Markman-style" claim chart is required for the Summary Section, which makes no sense because the PTO is an administrative agency not an Article III court for handling patent infringement cases that arise under 35 U.S.C. § 271, or allege requirements for a graphical presentation ("map of claims"), while still other Notices have creatively cited yet additional alleged defects, none of which are cited in the statute or the formal PTO rules. These apparently arbitrary and capricious actions ill-serve the interests of the Examining corps or the Board, and cause undesired and unnecessary delays in patent prosecution without benefit to the patent applicant.

reconsider the Notice, whereas the signatory to the Notice also appeared hesitant as to having authority for reconsideration and courteously suggested consulting the Examiner. This is indeed an odd situation where some one had 'authority' to issue the Notice, but no one seems to acknowledge having authority to reconsider it. (It is courteously submitted that Catch-22 situation raises still another issue of procedural due process.)

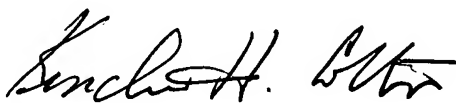
Conclusion

The Appellant therefore respectfully submits that the summary of claimed subject matter section of the Appeal Brief is fully compliant with the requirements of the Code of Federal Regulations and is in suitable condition to support consideration by the Board. The Appellant additionally respectfully requests that the PTO provide a copy of the crib sheet that lists what the PTO uses to refuse Appeal Briefs.

Appellants respectfully submit the Notice should be withdrawn, the Appeal Brief should be entered, and all rejections should be reversed.

Respectfully submitted,

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Date: January 11, 2007

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